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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/926,819	09/10/97	TSENG	M GC/7982ACIPC

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QM12/0203

EXAMINER

DEXTER, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

02/03/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/926,819**

Applicant(s)  
**Tseng**

Examiner  
**Clark F. Dexter**

Group Art Unit  
**3724**



☒ Responsive to communication(s) filed on Sep 27, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 20-41 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 20-26, 31, and 39-41 is/are allowed.

☒ Claim(s) 27-30 and 32-37 is/are rejected.

☒ Claim(s) 38 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. The amendment filed September 27, 1999 has been entered.

#### ***Information Disclosure Statement***

2. The information disclosure statements filed December 18, 1998 (paper #4) and September 27, 1999 (paper #8) have been received and the references listed thereon have been considered. Regarding paper #8, Applicant is requested to provide dates for the "Schick Protector cartridge" and for the "Copy of the package back label for Schick Protector cartridge", or state that the dates are unknown or not otherwise available.

#### ***Terminal Disclaimer***

3. The terminal disclaimer filed on September 27, 1999 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the full statutory term of any patent to be issued on application serial number 08/461,318 (in the event that the patent to be issued on application serial number 08/461,318 were to issue before the patent to be issued on this application) has been reviewed and is accepted. The terminal disclaimer has been recorded.

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***Claim Rejections - 35 USC § 112***

4. Claims 30 and 32-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 30, line 2, “adapted to change color” is vague and indefinite as to how the skin engaging member is “adapted”, and further the limitation is vague and indefinite since there is not sufficient structure set forth to perform the claimed function. ←

In claim 32, lines 11-12, the phrase “adapted to be immovably affixed to said razor cartridge and to erode” is vague and indefinite as to what is being set forth, particularly as to how the skin engaging layer is “adapted”. ←

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Wolf.

Wolf discloses a member (e.g., in Figs V-VII) with every structural limitation of the claimed invention including a means indicating a change in the amount of shaving aid (e.g., by squeezing the device).

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***Claim Rejections - 35 USC § 102/103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 28-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wolf.

Wolf discloses a member with every structural limitation of the claimed invention including at least one coloring agent (e.g., the color of the shaving soap). In the alternative, if it is argued that there is no disclosure of the shaving soap having a color, the Examiner takes Official notice that it would have been obvious to one having ordinary skill in the art to use a colored soap with the device of Wolf for various well known reasons including providing a visible indication on the outside of the device that soap is present.

***Allowable Subject Matter***

9. Claims 32-37 appear that they would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

10. Claims 31 and 38-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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11. Claims 20-26 are allowable over the prior art of record.

***Response to Arguments***

12. Applicant's arguments filed September 27, 1999 have been fully considered but they are not persuasive.

In the paragraph bridging pages 5 and 6 of the amendment, applicant argues that the "adapted to" language is appropriate. The Examiner respectfully submits that while the language is not inappropriate, it remains unclear as to what is being set forth. For example, in claim 32, it is not clear as to how the skin engaging layer is adapted to be immovably fixed to the razor cartridge. That is, it is not clear as to what structure is being set forth for the skin engaging layer and thus it is not clear as to what is required to meet this structure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cf  
January 31, 2000